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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|--------------------------------|------------------|
| 09/695,623 | 10/24/2000 | Hiroyuki Honma | 9792909-4845 | 2772 |
| 7590 | 12/17/2003 | | | |
| SONNENSCHN NATH & ROSENTHAL PO BOX 061080 WACKER DRIVE STATION - SEARS TOWER CHICAGO, IL 60606 | | | EXAMINER HOFFMAN, BRANDON S | |
| | | | ART UNIT 2136 | PAPER NUMBER |

DATE MAILED: 12/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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7590

11/26/2003

Charles P. Sammut
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2001 Ferry Building
San Francisco, CA 94111

EXAMINER

HOFFMAN, BRANDON S

ART UNIT

PAPER NUMBER

2171

DATE MAILED: 11/26/2003

7

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Office Action Summary

Application No.

09/695,623

Applicant(s)

HONMA, HIROYUKI

Examiner

Brandon Hoffman

Art Unit

2171

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Specification

2. The disclosure is objected to because of the following informalities:
 - On page 5, line 12, "blocks" should be ~~block~~.
 - On page 6, line 4, between "almost" and "same" should be ~~the~~.
 - On page 7, line 19, between "number" and "bits" should be ~~of~~.
 - On page 8, line 6, there is a right parentheses ")" without a left parentheses ~~(~~.
 - On page 10, line 19, and page 12, line 19, between "in" and "future" should be ~~the~~.
 - On page 12, line 2, "carrying" should be ~~carry~~.
 - On page 12, line 5, "is a half" should be ~~is half~~.
 - On page 12, line 16, between "is" and "same" should be ~~the~~.
 - On page 13, line 13, "signal" should be ~~signals~~.
 - On page 13, line 17, there is a right quote ' ' without a left quote ~~"~~.
 - On page 14, line 8, "olde" should be ~~old~~.
 - On page 15, line 1, "signal" should be ~~signals~~.
 - On page 16, line 5, and page 57, line 3, "by" should be ~~may~~.

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- On page 25, line 1 and 9, "focussing" should be ~~–focusing–~~. There are more instances of the misspelled word "focussing." Please fix all the occurrences of the word to be ~~–focusing–~~.
- On page 26, line 21, "magneto-optic disk" is missing its reference number (1).
- On page 31, line 10, between "corresponds" and "the" should be ~~–to–~~.
- On page 33, line 9, reference to "spectrum signal component 120c" should be ~~–120e–~~.
- On page 37, line 17, "as many as its" should be ~~–as many bits–~~.
- On page 61, line 10, "or not are recorded" should be ~~–or not recorded–~~ OR even ~~–or are not recorded–~~.
- On page 61, line 17, "TInformation" should be ~~–Information–~~.
- On page 67, line 10, between "may" and "feasibly" should be ~~–be–~~ OR between "feasibly" and "realized".
- On page 67, line 19, "if there is no code" should be ~~–if no code–~~.
- On page 68, line 5, "rea" should be ~~–area–~~ and "are" should be ~~–area–~~.
- On page 69, line 4, "flat" should be ~~–flag–~~.
- On page 69, lines 20 and 21, "it may alternatively so arrangement that" is unclear as to what the applicant is trying to say. Please rewrite this phrase so it is to become clearer.
- On page 73, line 19, "no" should be ~~–not–~~.

Appropriate correction is required.

Claim Rejections - 35 USC § 112 – 2nd Paragraph

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 11-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 11-18 recites the limitation "The information management method" in all the preambles of the above listed claims. There is insufficient antecedent basis for this limitation in the claim.

The independent claim, claim 10, that all the dependent claims refer to is 'The information management apparatus,' not an 'Information management method.'

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4, 6-8, and 10-13, 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsutsui et al. (U.S. Patent No. 6,314,391).

Regarding claims 1 and 10, Tsutsui et al. teaches:

An information management method/apparatus comprising (fig. 18):

- Generating protection information for protecting the storage area of a recording medium storing a second string of codes recorded by a second coding technique from any recording, editing and erasing operations of a first apparatus adapted to handle a first string of codes by a first coding technique and refer to the first management data stored in a first management area (fig. 18, address location 0 and 1 are the first string of codes by a first coding technique and refer to the first management data stored in a first management area. Once the first apparatus reads address location 0 and 1, it then reads location 5, then 116. From there it goes to location 200000, where the message "for reproducing signals of this disc, use B codec related reproducing device.");
- Arranging said protection information in the first management data area as one of said first management data (col. 17, line 61 through col. 18, line 2); and
- Protecting the storage area of the medium storing said second string of codes from any recording, editing and erasing operations of said first apparatus on the basis of said protection information when the medium storing said second string of codes is operated by said first apparatus (col. 18, lines 2-12).

Regarding claims 2 and 11, Tsutsui et al. teaches said first apparatus is permitted to reproduce only the part of the first string of codes on the basis of said protection information when a single string of codes generated by means of both said

first coding technique and said second coding technique is recorded on said recording medium (col. 18, lines 63-67).

Regarding claims 3 and 12, Tsutsui et al. teaches said protection information indicates that the area that can be used by said first apparatus for recording is made nil in said area on the medium or said area on the medium is made smaller than the allowable area of said first apparatus (col. 19, lines 12-31).

Regarding claims 4 and 13, Tsutsui et al. teaches said protection information indicates that the storage information of the address information indicating the position of the area on the medium that can be used for recording by said first apparatus is made equal to nil (fig. 18, address storage location position information 1 refers to location 116, which in turn refers to location 200000, which is made 0 or nil, and col. 18, lines 13-24).

Regarding claims 6 and 15, Tsutsui et al. teaches:

- A second management data area that can be referred to only by the second apparatus adapted to handle the second string of codes or both the first string of codes and the second string of codes is provided on said medium (fig. 18, address location 2, and col. 18, lines 25-48) and
- The first management data are arranged in said second management data area except said protection information (col. 18, lines 44-48 suggests that the once

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recorded first management data are now arranged in the second management data area because the second management data area has claimed the first address storage location that once was referenced by the first management data area. Hence, the first management data are arranged in said second management data area except said protection information).

Regarding claims 7 and 16, Tsutsui et al. teaches said second apparatus is adapted to refer to both said first management data area and said second management data area (col. 16, line 64 through col. 17, line 3).

Regarding claims 8 and 17, Tsutsui et al. teaches said second apparatus is adapted to disregard said first management data area and refers to only the second management data area when said protection information is arranged in said first management data area (col. 18, lines 25-42).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsutsui et al (U.S. Patent No. 6,314,391) in view of Nakashima et al. (U.S. Patent No. 5,708,650).

Regarding claims 5 and 14, Tsutsui et al. teaches all the limitations of claims 1 and 10, respectively. However Tsutsui et al. does not teach said protection information indicates that the protection mode of the track on the medium is prohibited from rewriting.

Nakashima et al. teaches said protection information indicates that the protection mode of the track on the medium is prohibited from rewriting (fig. 20, 'write-protection flag' and col. 3, lines 10-19).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to have the protection information indicate that the protection mode of the track on the medium is prohibited from rewriting, as taught by Nakashima et al., combined with the method/apparatus of Tsutsui et al. It would have been obvious to one of ordinary skill in the art to have protection information indicate the medium is prohibited from rewriting, as taught by Nakashima et al., combined with the method/apparatus of Tsutsui et al. because the protection flag allows data to remain on the medium for a user-added benefit.

Claims 9 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsutsui et al (U.S. Patent No. 6,314,391) in view of Takezawa (U.S. Patent No. 5,392,265).

Regarding claims 9 and 18, Tsutsui et al. teaches all the limitations of claims 1 and 6, and also claims 11, and 15-17, respectively. However, Tsutsui et al. does not teach said second apparatus initializes said first management data area and allows the medium to be used by said first apparatus for recording, editing and erasing when said second string of codes no longer exists on said medium.

Takezawa teaches said second apparatus initializes said first management data area and allows the medium to be used by said first apparatus for recording, editing and erasing when said second string of codes no longer exists on said medium (col. 2, lines 31-43).

It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to allow recording, editing, and erasing of data after a second string of codes no longer exists on a medium, as taught by Takezawa, combined with the method/apparatus of Tsutsui et al. It would have been obvious to one of ordinary skill in the art to allow recording, editing, and erasing of data after a second string of codes no longer exists on a medium, as taught by Takezawa, combined with the method/apparatus of Tsutsui et al. because this well known task is common in record

management of data on an optical medium. When data is added, deleted, or edited, the TOC is automatically updated to reflect the changes made. This implies that when a second string of codes is deleted, i.e. no longer exists on a medium, the TOC is updated to reflect the change, therefore informing the apparatus adapted to the old standards that information exists in the old format exclusively. This would allow the first apparatus recording, editing, and erasing rights.

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brandon Hoffman whose telephone number is 703-305-4662. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Brandon Hoffman

BH
11/24/03


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